

REMARKS

The Non-final Office Action mailed December 13, 2007, has been received and reviewed. Each of claims 1-29 and 31-46 stands rejected. No claims have been amended herein. Accordingly, claims 1-46 remain pending. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

Allowable Subject Matter

Applicant would like to thank the examiner for allowing claim 30.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestion or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must

be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections Based Upon Litchy et al.

Claims 1-6, 8, 11, 15-16, 24-28, 31-32, 34, 38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litchy et al., (America on line Tour Guide, 4th edition, 1998, hereinafter the “Litchy reference”). As the asserted combination of references fails to teach or suggest all the limitations set forth in the rejected claims, Applicants respectfully traverse the rejection, as hereinafter set forth.

Claim 1 recites a method of producing a unique modified account name based on a requested account name that has been determined to already exist. The method includes receiving a requested account name from a user and selecting a pre-existing word element from at least a pre-existing list of word elements. The method further includes combining the pre-existing word element and at least a stem of the requested account name to product a modified account name. The method also includes comparing the modified account name with a list of

existing account names to determine whether the modified account name is unique. The method further includes, if the modified account name is unique, presenting the modified account name to the user for acceptance. In contrast, the Lichty reference describes receiving a proposed account name from a user and presenting an available account name to the user for acceptance if the proposed account name is not available. *See* Lichty reference p. 442.

Applicants respectfully suggest that the Lichty reference does not describe “combining the pre-existing word element and at least a stem of the requested account name to produce a modified account name” as recited in claim one. The Lichty reference describes proposing an available account name, but not an account name using either a stem of a requested account name or a pre-existing word element. The Lichty reference does not explicitly state that the proposed account name is based on at least a stem of the requested account name. One example of a proposed account name, “TomLi5437,” is given in the Lichty reference. *See* Lichty reference p. 429. The “TomLi” appears to be based on author Tom Lichty’s name, but the Lichty reference does not describe deriving “TomLi” from a proposed account name. For example, TomLi could be taken from the account owner’s name rather than a proposed account name. The point is, the Lichty reference is silent regarding the origin of “TomLi” and the process used to generate the available account name. Not only is the Litchy reference silent as to how the “TomLi” portion of the proposed account name is chosen, it does not describe using a pre-existing word element for form part of the available account name. At best, the Lichty reference only suggests adding numbers to part of the account owner’s name.

Further, the Lichty reference does not describe “selecting a pre-existing word element from at least one pre-existing list of word elements” as recited in claim 1. As described above, the Lichthy reference does not describe using a pre-existing word to create an account

name. The Lichty reference gives no background as to how the numbers that formed part of the account name “TomLi5347” were selected. Specifically, choosing any part of the account name from a list is not described. The Lichty reference is completely silent with respect to how “TomLi5347” is generated.

Further, Applicants respectfully submit that the Lichty reference fails to describe “comparing the modified account name with a list of existing account names to determine whether the modified account name is unique,” as described in claim 1. The Lichty reference describes presenting an available account name, but no explanation is given as to how AOL determines that the name is available. *See* Lichty reference p. 442. Thus, comparing a modified account name with a list of existing account names is not taught or suggested by the Lichty reference.

Further still, Applicants respectfully submit that the Lichty reference fails to describe “if the modified account name is unique, presenting the modified account name to the user for acceptance,” as recited in claim 1. This limitation is based on determining the uniqueness of the account name by comparing the modified account name with a list of existing account names. The comparison of the modified account name is not described in the Lichty reference, as explained above. It follows then, that a presentation based on the comparison is not described in the Lichty reference.

Thus, Applicants respectfully submit that the Lichty reference fails to teach or suggest all of the limitations of independent claim 1. Therefore, a *prima facie* case of obviousness has not been established for this claim and, accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection thereof.

Further, claims 2-6, 8, 11, 32, 35, 38, 41, 42 and 45 depend either directly or indirectly from allowable claim 1 and define further features not described in the Lichty reference. For example, regarding claim 2, Applicants respectfully suggest that randomly selecting the pre-existing word element from the at least one pre-existing list of word elements is not described in the Lichty reference. The Lichty reference does not describe selecting words, selecting words from a list, or randomly selecting any element of an account name. The Lichty reference is silent on how the numerical elements and other parts of the proposed account name are selected.

Regarding claim 3, the Lichty reference does not describe the pre-existing word element being an adjective. There is not an adjective in “Tom Li 5437,” which is the only example of a generated account name given in the Lichty reference.

Regarding claim 4, the Lichty reference does not describe the pre-existing word element being an affix. There is not an affix in “Tom Li 5437,” which is the only example of a proposed account name given in the Lichty reference.

Regarding claim 5, the Lichty reference does not describe producing a second modified account name to the user for acceptance. Specifically, the Lichty reference describes suggesting “a name for you that is available.” “A name” is singular and indicates that only one name is suggested. *See* Lichty reference p. 442.

Accordingly, a *prima facie* case of obviousness has not been established for claims 2-6, 8, 11, 32, 35, 38, 41, 42 and 45 at least because of their dependency from allowable claim 1 and for the additional reasons given above. Thus, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2-6, 8, 11, 32, 35, 38, 41, 42 and 45.

Independent claim 16 recites a computer-readable medium having computer-executable instructions for a method of producing a unique modified account name based on a requested account name that has been determined to already exist. The method includes selecting a pre-existing word element from at least one pre-existing list of word elements and combining the pre-existing word element and at least a stem of the requested account name to produce a modified account name. The method also includes comparing the modified account name with a list of existing account names to determine whether the modified account name is unique. If the modified account name is unique, the modified account name is provided to the user for acceptance.

The Lichy reference was described previously with reference to claim 1. For reasons substantially similar to those given with reference to claim 1, Applicants respectfully suggest, that the Lichy reference does not describe “selecting a pre-existing word element from at least one pre-existing list of word elements and combining the pre-existing word element and at least a stem of the requested account name to produce a modified account name” as recited in claim 16. Specifically, the Lichy reference does not describe “a pre-existing word element,” “a pre-existing list of word elements,” or “combining a pre-existing word element with at least a stem of the requested account name to produce the modified account name.” As stated previously, the Lichy reference, at best, suggests adding numbers to part of the account owner’s name to create an available account name. Appending a word element or even letters to the stem of an account owner’s name is not described in the Lichy reference. Also, for reasons similar to those given with reference to claim 1, the Lichy reference fails to describe comparing the modified account name with a list of existing account names and presenting the modified account name after the comparison. Thus, Applicants respectfully submit that the Lichy

reference fails to teach or suggest all of the limitations of independent claim 16. Therefore, a *prima facie* case of obviousness has not been established for this claim and, accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection thereof.

Independent Claim 24 recites a computer-readable medium having computer-executable components for producing a unique modified account name based on a requested account name that has been determined to already exist. The system includes a user interface component for receiving an account name request. The system also includes a database component including at least one pre-existing list of word elements and a list of existing account names. The system also includes a name generating component for selecting pre-existing word elements from the at least one pre-existing list of word elements and combining the pre-existing word elements with at least a stem of the requested account name to produce modified account names, if the requested account name is not unique when compared to the list of existing account names. The system also includes a search component for comparing the modified account names with a list of existing account names to determine whether the modified account names are unique and, if the modified account names are unique providing the modified account names to the user for acceptance.

The Lichy reference was described previously with reference to claim 1. For reasons substantially similar to those given with reference to claim 1, the Lichy reference does not describe “at least one pre-existing list of word elements,” or combining the pre-existing word elements with at least a stem of the requested account name to produce modified account names. As described previously, the Lichy reference describes adding numbers to a portion of the account owner’s name. The Lichy reference does not describe adding words or even letters to a stem of the requested account name. In addition, for reasons similar to those given with

reference to claim 1, the Lichty reference fails to describe comparing the modified account name with a list of existing account names and presenting the modified account name after the comparison.

Thus, Applicants respectfully submit that the Lichty reference fails to teach or suggest all of the limitations of independent claim 24. Therefore, a *prima facie* case of obviousness has not been established for claim 24 and, accordingly. Further, claims 25-28 depend either directly or indirectly from allowable claim 24. Accordingly, a *prima facie* case of obviousness has not been established for claims 25-28, 34, 37, 40, and 43-44. Thus, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 24-28, 34, 37, 40, and 43-44.

Independent Claim 31 recites a method of producing a unique random account name in response to a request by a user. The method includes receiving a request to generate a unique random account name from a user. The method also includes providing without any input or suggestion of names from the user, a list of multiple alternate unique account names. Method also includes providing the user with the ability to select any one of said alternate unique account names, enter a new string for use as an account name or request an automated generation of a new list of multiple alternate unique account names.

The Lichty reference was described with reference to claim 1. Applicants respectfully suggest that the Lichty reference does not describe receiving a request to generate a unique random account name from a user. The Lichty reference describes providing a unique account name for the user after the account owner proposes an account name that is not available. In contrast, claim 31 recites “providing, without any input or suggestion of names from the user, a list of multiple alternate unique account names.” A specific and direct request to

provide or suggest a user account name is not described in the Lichty reference. In addition to not requesting a first random account name, the Lichty reference also does not describe “requesting an automated generation of a new list of multiple alternate unique account names.” As described previously, it appears that only one account name is suggested in the Lichty reference. Accordingly, the Lichty reference does not describe a list of multiple alternate account names. Thus, Applicants respectfully submit that the Lichty reference fails to teach or suggest all of the limitations of independent claim 31. Therefore, a *prima facie* case of obviousness has not been established for claim 31 and, accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection thereof.

B. Rejections Based Upon the Litchy reference in view of U.S. Patent Number 5,995,730.

Claims 7, 9-10, 12-14, 17-23, 29-30, 33, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Lichty reference in view of U.S. Patent Number 5,995,730 to Blinne (hereinafter the “Blinne reference”). As the asserted combination of references fails to teach or suggest all the limitations set forth in the rejected claims, Applicants respectfully traverse the rejection, as hereinafter set forth.

Independent claim 17 recites a method of producing a unique random account name in response to a request by a user. The method includes, in a computing environment, receiving a requested account name from a user. The method further includes selecting a first pre-existing word element from a database including at least one pre-existing list of word elements and selecting a second pre-existing word element from the database. The method also includes combining the first and second pre-existing word elements to produce a random account name. The method further includes comparing the random account name with a list of existing

account names to determine if the random account name is unique. If the random account name is unique, then the random account name is provided to the user for acceptance.

The Lichty reference was described previously with reference to claim 1. For reasons substantially similar to those given with reference to claim 1, Applicants respectfully suggest that the Lichty reference does not describe “a first pre-existing word element,” “a second pre-existing word element,” or “combining a first and second word element to provide a random account name.” As described previously, the Lichty reference describes adding numbers to a portion of the account owner’s name. The available account name proposed in the Lichty reference (“TomLi5347”) does not appear to be composed from two pre-existing word elements. Applicants respectfully disagree with the contention made in the Office Action that it would be obvious to use words to create a new account name given that “TomLi5347” contains letters and numbers. Also, for reasons similar to those given with reference to claim 1, the Lichty reference fails to describe comparing the modified account name with a list of existing account names and presenting the modified account name after the comparison. The Blinne reference fails to cure this deficiency.

Accordingly, Applicants respectfully submit that the Lichty reference fails to teach or suggest all of the limitations of independent claim 17. Therefore, a *prima facie* case of obviousness has not been established for this claim. Further, claims 18-22, 33, 36, 39, and 46 depend either directly or indirectly from allowable claim 17. Accordingly, a *prima facie* case of obviousness has not been established for claims 18-22, 33, 36, 39, and 46. Thus, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 17-22, 33, 36, 39, and 46.

Independent claim 23, recites a computer-readable medium having computer-executable instructions performing a method of producing a unique random account name and response to a request by a user. The method includes selecting a first pre-existing word element from a database including at least one pre-existing list of word elements. The method also includes selecting a second pre-existing word element from the database. Method further includes combining the first and second preexisting word elements to produce a random account name and comparing the account name with a list of existing account names to determine if the account name is unique. If the account name is unique, then the account name is provided to the user for acceptance.

The Lichy reference has been described previously with reference to claim 1. For reasons substantially similar to those given with reference to claim 17, the Lichy reference does not describe, “a first pre-existing word element,” “a second pre-existing word element,” and “combining the first and second pre-existing word elements to produce a random account name” as recited in claim 23. As described previously, the Lichy reference describes adding numbers to the account owner’s name. The available account name proposed in the Lichy reference (“TomLi5347”) does not appear to be composed from two pre-existing word elements. Applicants respectfully disagree with the contention made in the Office Action that it would be obvious to use words to create a new account name given that “TomLi5347” contains letters and numbers. Also, for reasons similar to those given with reference to claim 1, the Lichy reference fails to describe comparing the modified account name with a list of existing account names and presenting the modified account name after the comparison. Thus, Applicants respectfully submit that the Lichy reference fails to teach or suggest all of the limitations of independent claim 23. The Blinne reference fails to cure this deficiency. Therefore, a *prima facie* case of

obviousness has not been established for this claim and, accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection thereof.

CONCLUSION

For at least the reasons stated above, claims 1-46 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or jgolian@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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